



SEP 5 2001

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 3, 6, 8, 10, 13, 16, 17, 18, 19, 20, 22, 31, 35, 36, 37, 48, and 49 of the morning section and questions 7, 12, 13, 15, 18, 21, 25, 29, 34, 37, 38, 39, 40, and 44 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 65. On January 25, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made

regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which

will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 3, 6, 8, 10, 13, 16, 17, 18, 19, 20, 22, 31, 35, 36, 37, 48, and 49 and afternoon questions 7, 12, 13, 15, 18, 21, 25, 29, 34, 37, 38, 39, 40, and 44. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. You are a registered practitioner and filed a new application on behalf of John. All claims were drawn to a single invention. With the application, you submitted an offer to elect without traverse if the Office deems the application to be drawn to more than one invention, a search made by a foreign patent office, one copy each of the references deemed most closely related to the claimed subject matter, and a detailed discussion of the references pointing out with the particularity required by 37 C.F.R. § 1.111(b) and (c), how the claimed subject matter is patentable over the references. You also submitted a petition to make John's application special. John was 75 years of age at the time of filing, and in such poor health that his doctor had issued a certificate stating that John is unable to assist in the prosecution of his application. Which of the following, singularly or in combination, submitted with the petition, is not sufficient to result in the petition being granted?

I. The fee set forth in 37 C.F.R. § 1.17(i).

II. John's birth certificate showing his date of birth.

III. The doctor's certificate stating that John's health is such that he is unable to assist in the prosecution of his application.

(A) I

(B) II

(C) III

(D) II and III

(E) None of the above.

The model answer is selection E.

MPEP § 708.02. I is sufficient to result in the petition being granted. MPEP § 708.02, subpart (VIII). II is sufficient. MPEP § 708.02, subpart (IV). III is sufficient. MPEP § 708.02, subpart (III). Therefore, (A) through (D) are incorrect.

Petitioner argues that answer (A) is correct since a fee is not required for a grantable petition to make an application special on the basis of the applicant's age. Petitioner's arguments have been fully considered but are not persuasive. Taken alone, any one of items I through III would be a sufficient basis for a grantable petition to make the above-described application special. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this

question is denied.

Morning question 6 reads as follows:

6. Evidence that a claim may not comply with the second paragraph of 35 U.S.C. § 112 occurs in accordance with proper USPTO practice and procedure where:

(A) Remarks filed by applicant in a reply or brief regarding the scope of the invention differ and do not correspond in scope with the claim.

(B) There is a lack of agreement between the language in the claims and the language set forth in the specification.

(C) The scope of the claimed subject matter is narrowed during pendency of the application by deleting the originally much broader claims, and presenting claims to only the preferred embodiment within the originally much broader claims.

(D) Claims in a continuation application are directed to originally disclosed subject matter (in the parent and continuation applications) which applicants did not regard as part of their invention when the parent application was filed.

(E) All of the above.

The model answer is selection A.

In accordance with MPEP § 2172, part II, evidence that shows a claim does not correspond in scope with that which applicant regards as applicant's invention may be found, for example, in contentions or admissions contained in briefs or remarks filed by applicant. *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). (B) is incorrect. MPEP § 2172, part II, states, "As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979) agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section." (C) is incorrect. MPEP § 2172, part III indicates that the second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971) (Applicant was permitted to claim and submit comparative evidence with respect to claimed subject matter which originally was only the preferred embodiment within much broader claims (directed to a method). (D) is incorrect. MPEP § 2172, part III indicates that the fact that claims in a continuation application were directed to originally disclosed subject matter which applicants had not regarded as part of their invention when the parent application was filed was held not to prevent the continuation application from receiving benefits of the

filing date of the parent application under 35 U.S.C. 120. In re Brower, 433 F.2d 813, 167 USPQ 684 (CCPA 1970). (E) is incorrect because (B), (C), and (D) are incorrect.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Petitioner contends that each one of the fact patterns set forth in answers (A) through (D) would result in a failure to comply with the second paragraph of 35 USC 112. However, the discussion in the paragraph above shows otherwise. Limiting the scope of the claims during prosecution in the manner set forth in answer (C), for example, would clearly not be contrary to the second paragraph of 35 USC 112. Accordingly, model answer (A) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 8 reads as follows:

8. Which of the following is true?

(A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.

(B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.

(C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 C.F.R. §1.321(a).

(D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.

(E) (A), (B), and (C).

The model answer is selection C.

See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03, p.1400-13. Since (A), and (B) are incorrect, (E) is incorrect.

Petitioner argues that answer (E) is the correct answer based on the assertion that

the statements made in answers (A), (B) and model answer (C) are all correct. Petitioner's arguments have been fully considered but are not persuasive. As demonstrated by the above paragraph, the statements made in answers (A) and (B) are incorrect. Contrary to answer (C), for example, a reissue application may not be filed as a CIP of the original patent. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 10 reads as follows:

10. Independent claim 1, fully supported by the specification in a patent application states:

Claim 1. An apparatus comprising: a plastic valve; a copper pipe connected to the plastic valve; and an aluminum pipe connected to the plastic valve.

Which of the following claims, presented in the application, provide the basis for a proper rejection under 35 U.S.C. § 112, second paragraph?

Claim 2. The apparatus of claim 1, wherein said pipe is statically charged.

Claim 3. The apparatus of claim 1, wherein the outer surface of said copper pipe is statically charged.

Claim 4. The apparatus of claim 1, further comprising a thermostat connected to said plastic valve.

(A) Claim 2.

(B) Claim 3.

(C) Claim 4.

(D) Claims 2 and 3.

(E) Claims 3 and 4.

The model answer is selection A

MPEP § 2173.05(e). Claim 2 is indefinite because "said pipe" lacks antecedent basis. Claim 3 is definite, as "the outer surface" is an inherent part of the pipe and would not require antecedent recitation. Therefore, (B), (D), and (E) are incorrect. Claim 4 is definite as there is antecedent basis for "said plastic valve." Therefore, (C) is incorrect.

Petitioner argues that answer (D) is correct because “there is no antecedent basis for an outer surface.” Petitioner’s arguments have been fully considered but are not persuasive. The paragraph above explains that “the outer surface” is an inherent part of the pipe and would not require antecedent recitation. Accordingly, model answer (A) is correct and petitioner’s answer (D) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 13 reads as follows:

13. A United States patent issued to inventor Smith on January 6, 1998. The Smith patent had a total of nine claims, with claim 1 being the only independent claim. Smith subsequently became aware of prior art that was not before the examiner that likely invalidated claim 1 of the patent. Accordingly, Smith properly filed a narrowing reissue application on September 30, 1999 along with a reissue oath stating that he believed the original patent to be wholly or partly invalid by reason of the patentee claiming more than he had the right to claim in the patent. As filed, the reissue application sought to narrow the first limitation of claim 1 to distinguish over the new prior art. Claims 2 through 9 were rewritten in independent form. On March 15, 2000, while preparing a reply to an Office action in the reissue application, Smith determined that he would like to add further claims to provide a desired range of patent protection. Thus, on March 17, 2000, Smith submitted an amendment that, inter alia, added new claims 10-19 to the reissue application, with claims 10 and 16 being presented in independent form. Each of claims 10-15 was narrower than original claim 1 in certain aspects, but broader than original claim 1 in other aspects. Each of claims 16-19 was narrower than claim 1 in all aspects, and was fully supported by the original reissue oath. Smith also submitted on March 17 a supplemental reissue oath stating that he believed the original patent to be wholly or partly inoperative by reason of the patentee claiming less than he had the right to claim in the patent. Which of the following best describes a likely action by the examiner in response to the amendment?

(A) Each of claims 10-19 is rejected as being improper since the claims were added after the two-year anniversary of the original patent issuance.

(B) Each of claims 10-19 is examined on the merits.

(C) Claims 10-15 are rejected as being improper because they improperly seek to broaden the invention claimed in the original patent, and need not be further examined on their merits, but claims 16-19 are examined on the merits.

(D) Claims 16-19 are examined on the merits, and claims 10-15 are examined on the

merits if there is no prosecution history estoppel during the original prosecution relating to the broadened aspects of the claims.

(E) None of the above.

The model answer is selection C.

An effort to convert a narrowing reissue application to a broadening reissue application more than two years after issuance of the original patent is ineffective. Furthermore, a claim that is broader than the original claims in any aspect is a broadened claim for the purposes of reissue. Thus, claims 10-15 are improper (regardless of whether there is any prosecution history estoppel), and statements (B) and (D) are incorrect. Statement (A) is incorrect because claims 16-19 are narrower than the original patent claims and are fully supported by the original reissue oath. For that same reason, (C) is correct. (E) is incorrect because (C) is correct.

Petitioner argues that answer (B) is correct because the examiner may examine claims 10-15 and then reject those claims as improper. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement, such improperly presented claims are not "examined on the merits" as stated in answer (B). Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 16 reads as follows:

16. Which of the following statements regarding a proper prior art reference is true?

(A) Canceled matter in the application file of a U.S. patent is a prior art reference as of the filing date under 35 U.S.C. 102(e).

(B) Where a patent refers to and relies on the disclosure of a copending subsequently abandoned application, such disclosure is not available as a reference.

(C) Where the reference patent claims the benefit of an earlier filed, copending but subsequently abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure for the common subject matter and the claimed matter in the reference patent, the effective date of the reference patent as to the common subject matter is the filing date of the reference patent.

(D) Matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date.

(E) All foreign patents are available as prior art as of the date they are translated into English.

The model answer is selection D.

35 U.S.C. § 102(a). As explained in MPEP § 901.01, the “matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a), *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). See also MPEP § § 2127 and § 2136.02.” (A) is incorrect. 35 U.S.C. § 102(e). As stated in MPEP § 901.01, “Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102(e), see *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966).” (B) is incorrect. As stated in MPEP § 901.02, “*In re Heritage*, 182 F.2d 639, 86 USPQ 160 (CCPA 1950), holds that where a patent refers to and relies on the disclosure of a copending abandoned application, such disclosure is available as a reference. See also *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967).” (C) is incorrect. As MPEP § 901.02 indicates, where the reference patent claims the benefit of a copending but abandoned application which discloses subject matter in common with the patent, and the abandoned application has an enabling disclosure of the common subject matter and claimed matter in the reference patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application. *In re Switzer*, 77 USPQ 1, 612 O.G. 11 (CCPA 1948); *Ex parte Peterson*, 63 USPQ 99 (Bd. App. 1944); and *Ex parte Clifford*, 49 USPQ 152 (Bd. App. 1940).” (E) is incorrect. As stated in MPEP § 901.05, “In general, a foreign patent, the contents of its application, or segments of its content should not be cited as a reference until its date of patenting or publication can be confirmed by an examiner’s review of a copy of the document.”

Petitioner argues that answer (C) is correct. Petitioner’s arguments have been fully considered but are not persuasive. The discussion in the paragraph above shows that answer (C) is clearly an incorrect answer. Contrary to petitioner’s contention that answer (C) is ambiguous in its use of the terms “reference patent” and “abandoned application”, these two terms are used in a consistent manner throughout answer (C). Petitioner’s assertion that “reference patent” may be confused to mean “abandoned patent” is not well taken. Accordingly, model answer (D) is correct and petitioner’s answer (C) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 17 reads as follows:

17. In June 1997, Rene invents a circuit board device which automatically logs a computer onto the Internet without the need for entering passwords. During the prosecution of the patent for the circuit board device, Rene's patent practitioner files the following claims 1 and 2:

1. An electronic device for automatically logging onto the Internet comprising: communication means for communicating on the Internet, said communication means further comprising circuit means for automatically entering a password, and storage means for automatically storing a password for logging onto the Internet.
2. The device of claim 1 wherein the communication means is a desktop computer.

During the patent prosecution, the examiner cites as prior art a telephone with a memory, which automatically dials a telephone number. The examiner reasons that because the telephone can store the number in its memory, it would have been obvious to store a password in the memory as well. The examiner objects to claim 2 as being dependent upon a rejected claim. Being very eager to get patent protection and low on financial resources, Rene instructs the practitioner to combine claims one and two and allow the application to issue. One year and one day after issuance, Rene comes to you, a patent attorney, inquiring if her patent reads on a widely distributed, hand-held, pocket sized, portable device that is not a telephone and does not use a desktop computer to access the Internet automatically without a password, and if not, what corrective action is available. Which of the following choices is the best advice for Rene?

- (A) Since the two-year period for broadening has not expired, Rene may file a reissue with a declaration stating that the failure to claim more was due to error without deceptive intent. Rene may broaden her claims to the extent permitted by the prior art, since at no time did she narrow her claims to avoid the prior art.
- (B) Since the prior art device was a telephone, Rene is entitled to seek patent protection on all that which is not in the prior art. Rene should be able to obtain broadened patent protection by reissue of the patent.
- (C) Since Rene's original claim 1 was broadly written and since Rene narrowed her scope of patent protection by incorporating the limitations of the original claim 2 during the original prosecution, she is barred by the doctrine of recapture from enlarging her claims to the scope of the original claim 1.
- (D) Although Rene narrowed her claims during the original prosecution, she can file a declaration stating that the narrowing of her claims was not because she believed the prior

art precluded her from claiming more but due to financial concerns. Therefore, the narrowing of the claim was error without deceptive intent and Rene may file a reissue seeking broader claims.

(E) Rene should file a request for reexamination seeking to enlarge the scope of her patent protection.

The model answer is selection C.

Rene is barred by the recapture rule. MPEP § 1412.02. As to (A), see MPEP § 1412.02. Rene responded to a rejection by amending her claims, similar to Example B in MPEP § 1412.02, p.1400-10. As to (B), again recapture is the determinative factor. As to (D), the issue of financial concerns is of no import. As to (E) independent claims may not be broadened during a reexamination.

Petitioner argues that answer (D) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (D) is correct, the paragraph above explains that the issue of financial concerns is of no import. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 18 reads as follows:

Please answer questions 18 and 19 based on the following facts.

You are a registered patent practitioner handling prosecution of a patent application assigned to your client, Manufacturing Company, Inc. ("ManCo"). In discussing a reply to a first, non-final Office action with the sole named inventor (I. M. Putin) on August 11, 2000, you uncover evidence that suggests an individual employed by your client may have intentionally concealed the identity of a possible joint inventor (Phil Leftout). Leftout quit ManCo after a dispute with the company president, and is currently involved in litigation against ManCo over his severance package. You learn that Leftout would be entitled to additional severance payments if he were indeed a joint inventor. You decide it is necessary to further investigate the identity of the proper inventive entity and, if the inventive entity was misidentified on the application, determine the circumstances behind this misidentification. Particularly in light of the schedules of individuals with relevant information, such an investigation would take at least three months and perhaps longer to complete. The outstanding Office action issued 5½ months ago with a 3-month shortened statutory period for reply. The examiner has raised only minor matters of form

in the Office action, and you are confident the application would be in condition for allowance after you submit a reply. After discussing the matter with you, ManCo informs you they want the matter straightened out before any patent issues on the application.

18. How do you best advise ManCo?

(A) Recommend promptly filing a Request for Stay of Prosecution until you can complete your investigation, and upon completion of the investigation filing an appropriate reply to the outstanding Office action along with a petition and associated fees for a three month extension of time.

(B) Recommend promptly filing a petition and associated fees for a three month extension of time along with a Request for Stay of Prosecution until you can complete your investigation, and upon completion of the investigation filing an appropriate reply to the outstanding Office action.

(C) Recommend proceeding with prosecution by promptly filing an appropriate reply to the outstanding Office action along with a petition and associated fees for a three month extension of time; and allowing the patent to issue in Putin's name alone with the understanding that, if the investigation shows the possible joint inventor should have been named, correcting the inventorship after issuance of the patent in accordance with 37 C.F.R. § 1.48.

(D) Recommend promptly filing an appropriate reply to the outstanding Office action along with a petition and fees for a three-month extension of time and concurrently submitting a petition and associated fees for suspension of action for a reasonable time until you can complete your investigation.

(E) Recommend promptly filing a petition and associated fees for suspension of action for a reasonable time until you can complete your investigation.

The model answer is selection D.

(A), (B) and (E) are each wrong at least because action cannot be suspended in an application that contains an outstanding Office action or requirement awaiting reply by the applicant. 37 C.F.R. § 1.103; MPEP § 709. These recommendations, if followed, would likely lead to abandonment of the application. (C) is wrong at least because inventorship in an issued patent is properly corrected through 37 C.F.R. § 1.324, not § 1.48. Also, (C) is contrary to ManCo's instructions that the matter is to be straightened out before the application is allowed to issue as a patent, and may raise questions concerning compliance with the duty of candor before the USPTO.

Petitioner argues that answer (C) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (C) is correct, the paragraph above explains why answer (C) is incorrect. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 19 reads as follows:

Please answer questions 18 and 19 based on the following facts.

You are a registered patent practitioner handling prosecution of a patent application assigned to your client, Manufacturing Company, Inc. ("ManCo"). In discussing a reply to a first, non-final Office action with the sole named inventor (I. M. Putin) on August 11, 2000, you uncover evidence that suggests an individual employed by your client may have intentionally concealed the identity of a possible joint inventor (Phil Leftout). Leftout quit ManCo after a dispute with the company president, and is currently involved in litigation against ManCo over his severance package. You learn that Leftout would be entitled to additional severance payments if he were indeed a joint inventor. You decide it is necessary to further investigate the identity of the proper inventive entity and, if the inventive entity was misidentified on the application, determine the circumstances behind this misidentification. Particularly in light of the schedules of individuals with relevant information, such an investigation would take at least three months and perhaps longer to complete. The outstanding Office action issued 5½ months ago with a 3-month shortened statutory period for reply. The examiner has raised only minor matters of form in the Office action, and you are confident the application would be in condition for allowance after you submit a reply. After discussing the matter with you, ManCo informs you they want the matter straightened out before any patent issues on the application.

19. Further assume that the application is awaiting action by the Office at the time you complete your investigation. The investigation revealed that Leftout should indeed have been named as a joint inventor and that the error in naming the inventive entity resulted from Putin's assistant purposely omitting Leftout from an invention disclosure form to avoid increasing the value of Leftout's severance package. Although the application was originally filed with an inventor's Declaration and an Assignment to ManCo signed by Putin as a sole inventor, Putin did not realize at the time that he was not the sole inventor of the claimed subject matter. Leftout was unaware that the application had even been prepared and filed. Thus, neither Putin nor Leftout were aware that an error had been made in the named inventive entity. There was never any deceptive intent by either Putin or Leftout concerning the error. How do you correct the named inventive entity?

- (A) Promptly file a replacement declaration executed jointly by Putin and Leftout along with a cover letter explaining that Leftout was inadvertently omitted as an inventor.
- (B) Because Putin's assistant purposely omitted Leftout's name, the mistake in the named inventive entity was not an error without deceptive intention and the mistake cannot be corrected.
- (C) Simply file a continuation application naming Leftout and Putin as inventors and submit any necessary filing fee.
- (D) Amend the application to name Leftout and Putin as joint inventors and, along with the amendment, submit a petition including a statement from Leftout that the error in inventorship occurred without deceptive intention on his part, a declaration executed by both Putin and Leftout, and all necessary fees.
- (E) (C) and (D) are each an appropriate way to correct the named inventive entity.

The model answer is selection C.

Correction of inventorship may be made under the provisions of 37 C.F.R. § 1.48 or by filing a continuation application. MPEP § 201.03, second paragraph. Since the original application was filed with an inventor's declaration, correction cannot be made merely by submitting a correct declaration. See 37 C.F.R. § 1.48(a) and (f). Thus, (A) is incorrect. (B) is incorrect because there was no deceptive intention on the part of the omitted inventor, Leftout. Under the facts of the question, (D) is incorrect because it omits the written consent of ManCo required under 37 C.F.R. § 1.48(a)(4). MPEP § 201.03, under the heading "37 CFR 1.48(a)," part D. (E) is incorrect because (D) is incorrect.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 20 reads as follows:

20. Assume a "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a)-(d) was made and a certified copy of the foreign application was filed in a corresponding U.S. application on which the original U.S. patent was granted, and the

benefit of priority is desired in a reissue patent application. Which of the following statements accords with proper USPTO practice and procedure?

- (A) It is unnecessary to make such claim in the reissue application.
- (B) It is unnecessary to make such claim in the reissue application provided a certified copy of the foreign application is provided in the reissue application.
- (C) It is unnecessary to make such claim in a reissue application provided the oath or declaration identifies the foreign application and its filing date.
- (D) It is necessary to make such claim in the reissue application, and in addition, the oath or declaration must identify the foreign application on which priority is claimed, and any foreign applications having a filing date before that of the application on which priority is claimed.
- (E) It is necessary to make such claim in the reissue application, and in addition, a certified copy of the foreign application must be provided in the reissue application.

The model answer is selection D.

The statement complies with 35 U.S.C. § 119(a)-(d) and 51; 37 C.F.R. § 1.55 and 1.63; MPEP § 1417. (A), (B), (C), and (E) are wrong because their statements do not comply with MPEP § 1417.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 22 reads as follows:
22. Which of the following is true?

- (A) When the subject matter of an appeal is particularly difficult to understand, a patentability report is prepared by an examiner in order to present the technical background of the case to the Board of Appeals and Patent Interferences.
- (B) In those appeals in which an oral hearing has been confirmed and either the Board of

Appeals and Patent Interferences or the primary examiner has indicated a desire for the examiner to participate in the oral argument, oral argument may be presented by the examiner whether or not the appellant appears.

(C) If a patent applicant files a notice of appeal which is unsigned, it will be returned for signature, but the applicant will still receive the filing date of the unsigned notice of appeal.

(D) Statements made in information disclosure statements are not binding on an applicant once the patent has issued since the sole purpose of the statement is to satisfy the duty of disclosure before the Office.

(E) None of the above.

The model answer is selection B.

See MPEP § 1209, p.1200-23, "Participation by Examiner." As to (A), see MPEP § 705. As to (C) signature requirement does not apply. 37 C.F.R. § 1.196(b); MPEP § 1205. The notice will not be returned. As to (D), see *Gentry Gallery v. Berkline Corp.*, 134 F.3d 1473, 45 U.S.P.Q.2d 1498 (Fed. Cir. 1998)

Petitioner argues that answer (C) is correct in that "a signature will probably be requested by examiner and the application may be returned for a signature." Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that "a signature will probably be requested by examiner and the application may be returned for a signature", a signature requirement does not apply as explained above. Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 31 reads as follows:

31. Which of the following do not represent prior art?

(A) The preamble of a Jepson claim.

(B) A technical journal as of its date of publication which is accessible to the public as of the date of its publication.

(C) A doctoral thesis indexed, cataloged and shelved in a university library.

(D) A disclosure publicly posted on the INTERNET, but containing no publication or retrieval date.

(E) Applicant's labeling of one of the figures in the drawings submitted with his application as prior art.

The model answer is selection D.

See MPEP § 2128 under the subheading "Date of Availability," of the heading "Electronic Publications As Prior Art." (A) is wrong. See MPEP § 2129 under the heading "A Jepson Claim Results In An Implied Admission That Preamble Is Prior Art." (B) is wrong. See MPEP § 2128.02. A journal article or other publication becomes available as prior art on date it is received by at least one member of the public. (C) is wrong. See MPEP § 2128.01 under the heading "A Thesis Placed In A University Library May Be Prior Art If Sufficiently Accessible To The Public." (E) is wrong. See In re Nomiya, 184 USPQ 607, 610 (CCPA 1975); 35 U.S.C. § 102(d); MPEP § 2129 under the heading "Admissions By Applicant Constitute Prior Art."

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 35 reads as follows:

35. You, a registered patent practitioner, receive a Notice of Allowance and Issue Fee Due in an application you know is very important to your client, Acme Incorporated. The application has been pending for several years. In accordance with standing instructions from Acme, you immediately pay the issue fee and then report to the client receipt of the Notice of Allowance and payment of the issue fee. One week later, you receive a call from Acme's CEO informing you that three weeks earlier a competitor, Zenith Manufacturing, had forwarded to her copies of several prior art patents. Although she had never seen these prior art patents before, she immediately recognized their materiality to the claims of the pending Acme application. However, she was very busy with other business and therefore did not previously inform you of the patents. Given the importance of the application to Acme, she wants you to ensure that the examiner officially considers the prior art patents during prosecution of the Acme application.

Which of the following is likely to be your best course of action to ensure proper consideration of the prior art by the examiner, while minimizing unnecessary costs and delays in issuance of a patent to Acme?

(A) Promptly file an Information Disclosure Statement (“IDS”) signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.

(B) Promptly file an Information Disclosure Statement (“IDS”) signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS; and pay a fee for late submission of the IDS.

(C) Promptly file an Information Disclosure Statement (“IDS”) along with payment of a fee for late submission of the IDS.

(D) Promptly file an Information Disclosure Statement (“IDS”) signed by you that includes a statement that no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to your knowledge after a reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS; and submit a petition requesting consideration of the IDS and payment.

(E) Promptly petition to withdraw the application from issue, pay the necessary petition fee, and file continuation application along with an Information Disclosure Statement.

The model answer is selection E.

MPEP § 609(B)(4). Statements (A), (B) and (C) do not apply (at least) because the IDS was not filed within three months of the filing date or before the mailing date of a notice of allowance. 37 C.F.R. § 1.97(c). Statement (D) does not apply because the issue fee has been paid. 37 C.F.R. § 1.97(d).

Petitioner argues that answer (A) is correct. Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s arguments that answer

(A) is correct, the paragraph above explains why answer (A) is incorrect. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 36 reads as follows:

36. In July 1999, Pete Practitioner files a reissue application for Sam's patent on a combination washing machine and dryer, which issued on August 5, 1997. The original 20 claims are filed in the reissue application along with two additional dependent claims. The declaration indicates that there was error without deceptive intent in that applicant failed to claim the subject matter of the two newly added dependent claims. Sam also indicates in the declaration that he has no intention doing anything other than adding the two dependent claims. In September 1999 the examiner allows claims 1-10 of the reissue but rejects claims 11-22. Sam is eager to enforce claims 1-10 against a competitor but does not want to give up prosecuting claims 11-22. Sam also wants to add additional claims 23-30 directed to an entirely different invention, which was disclosed in the patent but not claimed. To claim the new invention, Sam must file new independent claims, which claim subject matter not previously claimed. Pete practitioner has retired and Sam comes to you for advice. Which of the following is true?

(A) Sam may file a second continuing reissue application with claims 11-20 as well as new claims 23-30. Sam would then cancel claims 11-20 from the first reissue application. The second reissue application would then issue and Sam could file a Notice of Appeal to the Board of Patent Appeals and Interferences in the first reissue application. Since the first application was filed within the two year time limit, Sam would not be subjected to a rejection for broadening his claims

(B) Since Sam's reissue application was filed within the two-year statutory time limit on broadening, Sam may add the additional claims 23 -30 to the reissue application.

(C) Although Sam's reissue application was filed within two years, Sam did not indicate his intention to broaden the claims until after the two year period had expired. Sam may not now file broader reissue claims.

(D) Since Sam had only one patent and all reissue applications for the same patent must issue simultaneously, it would not be advantageous to file two reissue applications since they must issue at the same time.

(E) Since the new invention was disclosed but not claimed in the original application,

Sam may file claims directed to this new invention at any time during the life of the patent since claiming entirely different subject matter in entirely new claims does not constitute broadening as long as the original claims are not broadened.

The model answer is selection C.

It is essential that Sam file broader claims and indicate his intention to broaden within the two year time limit of 35 U.S.C. § 251. See MPEP § 1412.03, p.1400-13, and *In re Graf*, 111 F.3d 874, 877, 42 USPQ2d 1471, 1473-74 (Fed. Cir. 1997). As to answer (D), according to MPEP § 1451, p.1400-38, the requirement of 37 C.F.R. § 1.177 requiring that all divisional reissue applications issue simultaneously will be routinely waived sua sponte. As to a continuation application, they may also issue at different times as explained at MPEP § 1451, p.1400-38. Since (C) is true, (A), (B) and (E) are false. Further as to (E), claims reading on subject matter not covered by the original claims are broader.

Petitioner argues that answer (A) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (A) is correct, the paragraph above explains why answer (A) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 37 reads as follows:

37. An Office action was mailed in a pending patent application on Wednesday, November 17, 1999. The examiner set a three month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Thursday, February 17, 2000 and paid the appropriate one-month extension fee. No further papers or fees were submitted and the application became abandoned. What was the date of abandonment?

- (A) Friday, February 18, 2000.
- (B) Friday, March 17, 2000.
- (C) Saturday, March 18, 2000.
- (D) Monday, March 20, 2000.
- (E) Thursday, May 18, 2000.??2

The model answer is selection C.

The one-month extension of time filed February 17, 2000 properly extended the deadline for filing a reply to Friday, March 17, 2000. When a timely reply is ultimately

not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, i.e., the application was abandoned at 12:01 AM on Saturday, March 18, 2000. The fact that March 18 was a Saturday does not change the abandonment day because the reply was due on March 17, a business day. MPEP § 710.01(a).

Petitioner argues that answer (B) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (B) is correct, the paragraph above explains why answer (B) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 48 reads as follows:

48. A nonprovisional patent application is filed on June 3, 1999, and on September 3, 1999, an Office action is mailed setting a 3 month shortened statutory period for reply. On March 3, 2000, a proper reply is filed together with a petition for a 3 month extension of time accompanied by the appropriate petition fee. A proper petition for conversion of the nonprovisional patent application to a provisional patent application along with the appropriate petition fee is deposited with the U.S. Postal Service as Express Mail pursuant to 37 C.F.R. § 1.10 on Saturday, June 3, 2000. Assuming the petition for conversion is granted shortly thereafter, which of the following statements is true?

- (A) The provisional application is entitled to a filing date of June 3, 1999.
- (B) The provisional application is entitled to a filing date of September 3, 1999.
- (C) The provisional application is entitled to a filing date of March 3, 2000.
- (D) The provisional application is entitled to a filing date of June 3, 2000.
- (E) None of the above.

The model answer is selection A.

Under 37 C.F.R. § 1.53(c)(2), a nonprovisional patent application "may be converted to a provisional application and be accorded the original filing date of the" nonprovisional patent application. MPEP § 601.01(c). (B), (C), and (D) are wrong because they recite dates other than the original filing date of the nonprovisional patent application. (E) is wrong because (A) is correct.

Petitioner argues that answer (D) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (D) is correct, the paragraph above explains why answer (D) is incorrect. Accordingly, model answer (A) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 49 reads as follows:

49. Which of the following is true?

- (A) When an applicant petitions to make his case special, he forfeits the opportunity to request an oral hearing if he should decide to appeal his application to the Board of Patent Appeals and Interferences.
- (B) An oral hearing is a good way to argue a case before the Board of Patent Appeals and Interferences as an appeal decided by an oral hearing is likely to be given closer consideration by the Board of Appeals and Patent Interferences than those without such a hearing.
- (C) During an appeal to the Board of Appeals and Patent Interferences, it is a good idea to schedule the oral hearing before filing a reply brief so that if questions arise at the hearing they may be responded to in the reply brief.
- (D) A rehearing of an appeal involves conducting an oral hearing a second time.
- (E) None of the above.

The model answer is selection E.

As to (A), see MPEP § 708.02 where no such requirement is stated. See also, MPEP § at 1200-2 under Special Case. As to (B), see MPEP § 1209 and 37 C.F.R. § 1.194. As to (C), reply brief must be filed within two months of examiner's Answer. MPEP § 1208.03. As to answer (D), see MPEP § 1214.03 at MPEP § 1200-28.

Petitioner argues that answer (C) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (C) is correct, a reply brief may be filed in response to an Examiner's Answer - not an oral hearing at the Board of Appeals and Patent Interferences. Accordingly, model answer (E) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 7 reads as follows:

7. Which of the following is true?

(A) Once an application is ready to be issued, there is a public policy that the patent will issue in regular course once the issue fee is timely paid. In accordance with the foregoing, issuance of a patent may not be deferred.

(B) The time period set for the payment of the issue fee is statutory and cannot be extended.

(C) While anyone may file a request for ex parte reexamination, a patent practitioner filing a request for ex parte reexamination must disclose the client's name.

(D) It is necessary to claim priority under 35 U.S.C. § 120 to earlier filed applications for which a corresponding claim of priority has been made in the corresponding foreign filed applications of the same applicant.

(E) (A), (B), and (C).

The model answer is selection B.

See 35 U.S.C. § 151; MPEP § 1306. As to (A) see MPEP § 1306.01. As to (C) see MPEP § 2212. As to (D), the claim for priority is not required as a person may not wish to do so in order to increase the term of his or her patent. Since (A) and (C) are incorrect, (E) is incorrect.

Petitioner argues that answer (D) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (D) is correct, the paragraph above explains why answer (D) is incorrect. Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:

12. Which of the following is true?

(A) Claims may be properly rejected on the ground that applicant has disclaimed the subject matter involved if the applicant fails to copy a claim from a patent when suggested by the examiner.

(B) Res Judicata, as a proper ground for rejection, should be applied when the earlier decision was a final rejection by the same examiner.

(C) If an article of manufacture capable of illustration is originally claimed and it is not shown in the drawing, the claim should be rejected based on the reason the claimed subject matter is not shown in the drawing, and applicant is required to add it to the drawing.

(D) A thing occurring in nature, which is substantially unaltered, such as a shrimp with the head and digestive tract removed, is a “manufacture.”

(E) A scientific principle, divorced from any tangible structure, is a statutory class of patentable subject matter.

The model answer is selection A.

MPEP § 706.03(u). (B) is incorrect. MPEP § 706.03(w) Res Judicata should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision. (C) is incorrect. MPEP § 608.01(l) and 706.03(o). If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim should not be rejected, but on that basis applicant is required to add it to the drawing. (D) is incorrect. As stated in MPEP § 706.03(a), “A thing occurring in nature, which is substantially unaltered, is not a ‘manufacture.’ A shrimp with the head and digestive tract removed is an example. *Ex parte Grayson*, 51 USPQ 413 (Bd. App. 1941).” (E) is incorrect. MPEP § 706.03(a) indicates that a scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. *O’Reilly v. Morse*, 56 U.S. (15 Howard) 62 (1854).

Petitioner argues that answer (C) is correct. Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s arguments that answer (C) is correct, the paragraph above explains why answer (C) is incorrect. Accordingly, model answer (A) is correct and petitioner’s answer (C) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 13 reads as follows:

13. On February 3, 1999, you filed an application for inventor Sam, fully disclosing and claiming only the following:

Claim 1. A system for preventing unauthorized entry into a garage, comprising: an electric garage opener coupled to a computer and to a video camera.

You received a non-final Office action dated February 4, 2000, wherein the examiner rejected claim 1 under 35 U.S.C. § 102(b) as anticipated by Dan. The examiner attached a copy of Dan's journal article published on July 4, 1997, fully disclosing an electric garage opener coupled to a computer and to a video camera. Which of the following actions, if taken by you, can overcome the rejection in accordance with proper USPTO practice and procedure?

- (A) Timely filing a reply traversing the rejection, arguing that claim 1 is patentably distinguished from the Dan reference.
- (B) Timely filing a reply traversing the rejection, arguing that since the date of the Dan reference falls on a Federal holiday, the Dan reference is not a statutory bar under 35 U.S.C. § 102(b).
- (C) Timely filing a reply with an affidavit under 37 C.F.R. § 1.131 showing prior invention by Sam.
- (D) Timely filing a reply traversing the rejection, arguing that the examiner did not demonstrate why one of ordinary skill in the art at the time the invention was made would have been motivated to modify the system disclosed by Dan.
- (E) Timely filing a reply including an amendment to the specification perfecting priority under 35 U.S.C. § 120, containing a specific reference in accordance with 37 C.F.R. § 1.78(a), to a U.S. application filed by Sam on July 3, 1997 that fully disclosed but did not claim a garage opener coupled to a computer and a video camera.

The model answer is selection E.

MPEP § 706.02(b). (A) is incorrect because the Dan reference includes all the elements of claim 1. (B) is incorrect because the Federal holiday is merely to move the statutory bar date to the next succeeding business day. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960). (C) is incorrect because a 37 C.F.R. § 1.131 affidavit can not be used to overcome a rejection under 35 U.S.C. § 102(b). (D) is incorrect because the rejection was not made under 35 U.S.C. § 103.

Petitioner argues that answer (A) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (A) is correct, the paragraph above explains why answer (A) is incorrect. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 15 reads as follows:

15. In December 1987, Molly invents a new potato cutter that cuts the potatoes into shapes having a star cross section. Because of the proximity of the star outer surface to the inter core of the potato, the shape achieves optimal cooking of the potato when fried without resulting in an overly cooked outer surface. Molly, thinking that the invention is important, has two people, Sue and Tom, both sworn to secrecy, witness a drawing of the invention. Molly then locks the drawing in a safe deposit box where it remains for the next twelve years. Neither Molly, Sue, or Tom discloses the invention to anyone for the next twelve years. In December 1999, Troy invents a new potato cutter which produces potatoes having a star cross section, and the potatoes are then fried. The invention becomes an overnight success. Troy files a patent application on February 1, 2000. Molly, after seeing the success of Troy's invention in the marketplace, decides to file an application, also on February 1, 2000. The examiner is unable to find any prior art and no other prior art is cited by either applicant. Which of the following is true?

- (A) Since Molly invented the cutter before Troy, she is entitled to a patent and not Troy.
- (B) Since Troy conceived of the idea after Molly and because Troy did not file a patent application before Molly, he is not entitled to priority over Molly.
- (C) Since Molly disclosed the invention to Sue and Tom, the invention was known by others prior to the invention by Troy. Therefore, Troy is precluded by 35 U.S.C. § 102(a) from obtaining a patent on his idea.
- (D) Since Molly effectively concealed her invention, Troy is entitled to a patent since although Molly conceived of the idea prior to Troy, she effectively abandoned the invention by not filing for twelve years.
- (E) None of the above.

The model answer is selection D.

35 U.S.C. § 102(g) applies only when another inventor has not abandoned, suppressed or concealed the invention. In this case, Molly concealed the invention for 12 years. It was not until she saw the popularity of Troy's device that she filed a patent application. (A) is not true because Molly concealed the invention. (B) is not true since the invention of Molly was concealed for 12 years and effectively abandoned. (C) is not

true since §102(a) applies only when the invention is publicly known by others. Since (D) is true, (E) is not.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 18 reads as follows:

18. Sally, an employee of Ted, conceived of and reduced to practice a spot remover for Ted on May 1, 1997. Sally's spot remover was made from water, chlorine, and lemon juice. On June 2, 1997, Sally filed a nonprovisional U.S. patent application for the spot remover, and assigned the entire rights in the application to Ted. Sally's assignment was not recorded in the USPTO, but was referred to in her application. On June 12, 1998, Jane, also an employee of Ted, having no knowledge of Sally's spot remover, conceived of and reduced to practice a spot remover for Ted. Jane's spot remover was made from carbonated water, chlorine, and lemon juice. On May 26, 1998, the USPTO granted Sally a patent. On November 6, 1998, Jane filed a nonprovisional U.S. patent application for the spot remover. As noted in Jane's application, Jane assigned the entire rights in her application to Ted. Jane's assignment was duly recorded in the USPTO. The examiner mailed a non-final Office action rejection under 35 U.S.C. § 103 to Jane in October 2000, citing the patent to Sally as prior art. Which of the following, if timely filed by Jane, would be effective in disqualifying Sally's patent?

I. An affidavit by Jane stating that the application files of Sally and Jane both refer to assignments to Ted.

II. A copy of Sally's assignment to Ted, clearly indicating that common ownership of Jane's and Sally's inventions existed at the time Jane's invention was made.

III. An affidavit by Ted stating sufficient facts to show that there is common ownership of the Sally and Jane inventions and that common ownership existed at the time the Jane invention was made.

- (A) I
- (B) II
- (C) III
- (D) II and III

(E) None of the above.

The model answer is selection E.

Sally's patent is prior art under 35 U.S.C. § 102(a) and cannot be disqualified by a showing of common ownership, which can be used to disqualify prior art under 35 U.S.C. 102(f) and (g). 37 C.F.R. § 1.104(a)(5); MPEP §§ 706.02(l) ("If the subject method qualifies as prior art under any other subsection (e.g., subsection 35 U.S.C. 102(a) . . .) it will not be disqualified as prior art under 35 U.S.C. 103."), and 706.02(l)(2).

Petitioner argues that answer (D) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (D) is correct, the paragraph above explains why answer (D) is incorrect. Accordingly, model answer (E) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 21 reads as follows:

21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make a amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

(A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.

(B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review

and approval.

(D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.

(E) Options (B) and (C) are equally likely to lead to the most favorable result.

The model answer is selection C.

(A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

Petitioner argues that answer (D) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (D) is correct, the paragraph above explains why answer (D) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 25 reads as follows:

25. Which of the following statements concerning reliance by an examiner on common knowledge in the art, in a rejection under 35 U.S.C. § 103 is correct?

I. Applicant can traverse an examiner's statement of common knowledge in the art, at any time during the prosecution of an application to properly rebut the statement.

II. An examiner's statement of common knowledge in the art is taken as admitted prior art, if applicant does not seasonably traverse the well known statement during examination.

III. If applicant rebuts an examiner's statement of common knowledge in the art in the next reply after the Office action in which the statement was made, the examiner can never provide a reference to support the statement of common knowledge in the next Office action and make the next Office action final.

(A) I

- (B) II
- (C) III
- (D) I and II
- (E) None of the above.

The model answer is selection B.

MPEP § 2144.03. I is incorrect because an applicant must seasonably traverse the well-known statement or the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 60 USPQ 239 (CCPA 1943). Therefore (A) and (D) are incorrect. III is incorrect because the action can potentially be made final. Therefore (C) is incorrect. (E) is incorrect because (B) is correct.

Petitioner argues that answer (D) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (D) is correct, the paragraph above explains why answer (D) is incorrect. Accordingly, model answer (B) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 29 reads as follows:

29. Your Canadian client, UpNorth Incorporated, came to you on August 11, 2000 with a valuable invention for pulping timber. UpNorth informed you it had been successfully using the invention commercially for the past fourteen months deep in the Canadian forests. The invention has not been used anywhere else by UpNorth, and the pulped timber from the UpNorth operations has not left Canada. At least one competitor, another Canadian company, lawfully observed the invention in operation during its first month of use with no restriction as to confidentiality or disclosure. UpNorth filed a Canadian patent application prior to commercial use of the invention, but (in an effort to hold down expenses) chose not file a corresponding application in the United States. The Canadian patent application remains pending. UpNorth just learned that two months ago its competitor began using the invention commercially in the United States. The invention was never disclosed or used in the United States prior to two months ago. UpNorth would like for you seek a United States patent on the invention to block the competitor from continued use of the invention. Which of the following would be reasonable advice from you to UpNorth?

(A) Since Canada is a NAFTA country, UpNorth is precluded from getting a United States patent because the Canadian application was filed more than twelve months ago and the invention was in public use more than one year prior to any possible United

States filing date for an UpNorth patent application.

(B) UpNorth should promptly file an application in the United States claiming the benefit of the filing date of the Canadian application and should fully disclose the Canadian commercial activities, the observation of the invention in Canada by UpNorth's competitor, and the competitor's commercial activities in the United States.

(C) UpNorth should promptly file an application in the United States without claiming the benefit of the filing date of the Canadian application and should fully disclose the Canadian commercial activities, the observation of the invention in Canada by UpNorth's competitor, and the competitor's commercial activities in the United States.

(D) UpNorth should abandon the pending Canadian application to avoid the possibility the Canadian application could be used as prior art against a United States patent application, and then file a patent application in the United States.

(E) Since UpNorth's activities concerning the invention all took place in Canada, the competitor's commercial use in the United States prior to any possible United States filing date for an UpNorth patent application precludes UpNorth from obtaining a United States patent.

The model answer is selection C.

With regard to Statement (A), public use in Canada is not a statutory bar under 35 U.S.C. § 102(b) regardless of whether Canada is a NAFTA country. MPEP § 706.02(c). Thus, although UpNorth cannot claim priority to the Canadian application under 35 U.S.C. § 119, their commercial activity is not a bar. Statement (B) is incorrect because UpNorth cannot rely on the Canadian application for priority. 35 U.S.C. § 119. Under the given facts, the Canadian application would not be prior art against a U.S. application regardless of whether the Canadian application was abandoned. Thus, (D) is not reasonable advice. Under 35 U.S.C. § 104, UpNorth can rely on Canadian activities to establish a date of invention prior to the competitor's commercial use in the United States. Statement (E) is therefore not reasonable advice.

Petitioner argues that answer (B) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (B) is correct, the paragraph above explains why answer (B) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 37 reads as follows:

37. You have taken over prosecution of a patent application in January 1998 that had previously been handled by another patent practitioner. The original application had been filed with all required fees, a preliminary amendment, and a signed inventor's declaration referring to the original application. The original application contained independent claims 1 and 7 and dependent claims 2-6 and 8-14. The preliminary amendment added independent claim 15 and dependent claims 16-19, but made no changes to the specification. A first, nonfinal Office action issued wherein the examiner determined that claim 17 included new matter. The examiner rejected claim 17 on this basis and required cancellation of the claim. All other claims were allowed. You have been asked to respond to the Office action. Which of the following is the most reasonable reply?

(A) File a Request for Reconsideration explaining that since the Preliminary Amendment was filed concurrently with the original application, the examiner should consider the Preliminary Amendment to be part of the original disclosure and the rejection should be removed.

(B) File a Petition under 37 C.F.R. § 1.181 for a review of the examiner's determination that claim 17 includes new matter along with any required fees.

(C) File a Notice of Appeal along with any required fees.

(D) Submit a new inventor's declaration that refers to both the original application and the preliminary amendment along with a Request for Reconsideration explaining that since the Preliminary Amendment was filed concurrently with the original application, the examiner should consider the Preliminary Amendment to be part of the original disclosure and the rejection should be removed.

(E) Submit a new inventor's declaration that refers to both the original application and the preliminary amendment, file a Petition under 37 C.F.R. § 1.182 along with the petition fee, requesting that the original oath or declaration be disregarded and that the application be treated as an application filed without an oath or declaration, and pay the surcharge for missing parts.

The model answer is selection E.

MPEP §§ 608.04(b) and 608.04(c). Answer (A) is incorrect because the preliminary amendment does not enjoy the status as part of the original disclosure in an application accompanied by a signed declaration unless the preliminary amendment is referred to in the declaration. (B) is incorrect because a petition under §1.181 would only be appropriate if the new matter is confined to the specification. If the new matter is

introduced into or affects the claims, the question becomes an appealable one. (C) is incorrect because the Office action is a first, non-final action and the issue is therefore not yet ripe for appeal. 37 C.F.R. § 1.191. (D) is incorrect because the original disclosure cannot be altered merely by filing of a subsequent oath or declaration referring to different papers.

Petitioner argues that answer (B) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (B) is correct, the paragraph above explains why answer (B) is incorrect. Accordingly, model answer (E) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 39 reads as follows:

39. AI files an application for a patent. After the Notice of Allowance is mailed and the issue fee has been paid AI discovers a prior art reference which is material to patentability. What should AI do?

(A) AI should file a prior art statement under 37 C.F.R. § 1.501 that will be placed in the patent file upon issuance of the application as a patent.

(B) Since the issue fee has been paid, AI no longer has a duty to disclose to the Office material prior art. He is under no obligation to submit the prior art reference to the Office.

(C) Since the issue fee has been paid, it is too late to have the examiner consider the reference in this application. AI should file a continuation application to have the reference considered and allow the original patent application to issue as a patent.

(D) AI should file a petition to have the application withdrawn from issuance, citing the finding of additional material prior art as the reason for withdrawal. A continuation application should also be filed with an information disclosure statement containing the reference in order to have the reference considered.

(E) AI should file an amendment under 37 C.F.R. 1.312 deleting all of the claims which are unpatentable over the reference since an amendment deleting claims is entitled to entry as a matter of right.

The model answer is selection D.

See 37 C.F.R. § 1.313(b); MPEP §§ 609, subpart (B)(4) and 1308. After payment

of the issue fee it is impractical for the Office to consider any information disclosures. As to (A), a prior art statement is applicable only to patent, not application, files. 37 C.F.R. § 1.501. As to (B), duty of disclosure continues until the patent is issued. As to (C), the patent should not be allowed to issue since it may contain invalid claims. As to (E) no amendment is entitled to entry after payment of the issue fee. 37 C.F.R. § 1.312(b).

Petitioner argues that answer (A) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (A) is correct, the paragraph above explains why answer (A) is incorrect. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 40 reads as follows:

40. Stan, through a registered practitioner, files an application for a patent. During the prosecution of Stan's patent, in an amendment, the practitioner admitted in his discussion as to "all the claims" of Stan's application, that "the most pertinent available prior art known to the Applicants and their representatives is the Acme Patent, cited by the examiner." Within one year after the patent issues, Stan comes to you and wants to file a reissue to broaden his claims, based on the fact that the Acme patent is not prior art. He has ample evidence to show that he conceived and reduced his invention to practice before the filing date of the Acme patent. Which of the following is true?

(A) Stan should file a reissue application accompanied by a declaration under 37 C.F.R. 1.131 to swear behind the date of the Acme reference. The statement by the registered practitioner, who formerly represented Stan, that the Acme patent was prior art constituted error without deceptive intent and may be corrected by reissue.

(B) Stan should file a request for reexamination and submit the Acme patent along with evidence in the form of affidavits or declarations showing that the Acme patent is not prior art.

(C) The explicit admission by registered practitioner, who formerly represented Stan, that the Acme patent constituted prior art is binding on Stan in any later proceeding involving the patent.

(D) Since Acme patent was cited by the examiner and not by the registered practitioner, who formerly represented Stan, Stan can not be held accountable for the error. Moreover, the statement by was directed to the pertinence of the prior art and not to the issue of whether the date of the Acme patent could be sworn

behind. Accordingly, the statement has no binding effect.

(E) (A) and (D).

The model answer is selection C.

Admissions by applicant constitute prior art. As explained in *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985), the Fed. Circuit found that the district court decided on two separate and independent grounds that the Aokage patent was such prior art. One basis was Tyler's admission of the Aokage reference as prior art before the PTO during the prosecution of the '922 Subera patent. The court found that, in a wrap-up amendment, the Tyler attorney admitted in his discussion as to "all the claims" of the three Subera applications, that "the most pertinent available prior art known to the Applicants and their representatives is the Aokage U.S. Patent 4,026,121 cited by the Examiner" (emphasis added). In view of this explicit admission, the district court's decision was proper and was sufficiently based on clear and convincing evidence. The controlling case law in this court recognizes this principle. See *Aktiebolaget Karlstads Mekaniska Werkstad v. ITC*, 705 F.2d 1565, 1574, 217 U.S.P.Q. (BNA) 865, 871 (Fed. Cir. 1983); *In re Fout*, 675 F.2d 297, 300, 213 U.S.P.Q. (BNA) 532, 536 (CCPA 1982), and *In re Nomiya*, 509 F.2d 566, 571, 184 U.S.P.Q. (BNA) 607, 612 (CCPA 1975). Thus, we must affirm the court's decision that the Aokage patent was prior art and as such binding on Tyler. (Here again, we do not pass on the other grounds on which the court concluded that the Aokage was prior art within the meaning of 35 U.S.C. § 102.) Since (C) is true, (D) is not true. Answers (A), (B) and (D) also are not true since the Acme patent can not be sworn behind or otherwise removed as a result of the admission. (E) is not true because (A) and (D) are not true.

Petitioner argues that answer (E) is correct. Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that answer (E) is correct, the paragraph above explains why answer (E) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 44 reads as follows:
44. Which of the following is true?

(A) A claim to a process omitting a step in a process, where the step is disclosed in the specification to be essential to the invention, may not be properly rejected under 35 U.S.C. 112, first paragraph, for lack of enablement where the specification provides an

enabling disclosure for the process which includes the essential step.

(B) A claim failing to interrelate essential elements of the invention as defined by the applicant in the specification, where the interrelation is critical to the invention may be properly rejected under 35 U.S.C. 112, second paragraph, for failure to properly point out and distinctly claim the invention.

(C) The best mode requirement is the same as the enablement requirement of the first paragraph of 35 U.S.C. 112.

(D) If the best mode contemplated by the inventor at the time of filing the application is not disclosed, a proposed amendment adding a specific mode of practicing the invention would not be new matter.

(E) Failure to disclose the best mode must rise to the level of active concealment or grossly inequitable conduct in order to support a rejection under 35 U.S.C. 112, first paragraph.

The model answer is selection B.

As stated in MPEP § 2172.01, “a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968).” (A) is incorrect. As stated in MPEP § 2172.01, “A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP § 2164.08(c). (C) is incorrect. As stated in MPEP § 2165.02, “The best mode requirement is a separate and distinct requirement from the enablement requirement of the first paragraph of 35 U.S.C. 112. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969). (D) is incorrect. MPEP § 2165.01, part V indicates that if there is no disclosure of the best mode contemplated by the inventor at the time the application is filed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. *In re Hay*, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type should be treated as new matter. MPEP § 2165.01. (E) is incorrect. As stated in MPEP § 2165, “Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement

has not been satisfied. *Union Carbide Corp. v. Borg - Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).”

Petitioner argues that answer (A) is correct. Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s arguments that answer (A) is correct, the paragraph above explains why answer (A) is incorrect. Accordingly, model answer (B) is correct and petitioner’s answer (A) is incorrect.

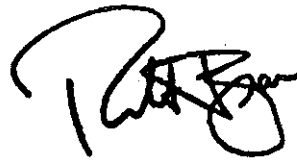
No error in grading has been shown. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 65. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy